

REMARKS

Upon entry of the present amendment, claims 1-3 and 5-13 will remain pending in the above-identified application and stand ready for further action on the merits.

Claim Amendments

By this amendment, claim 4 is canceled and the limitations thereof added to claim 1. The dependency of claims 12 and 13 is revised. No new matter is added by this amendment.

Allowable Subject Matter

Claims 8 and 11 stand objected to as being directed to allowable subject matter, but depending from a rejected claim. Applicants thank the Examiner for the indication of allowable subject matter, but believe that all pending claims are now directed to allowable subject matter.

Claim Rejections under 35 USC 102(b)

Claims 1-3, 6, 7, 9, 10, 12 and 13 stand rejected under 35 USC 102(b) as being anticipated by Barton et al. This rejection is respectfully traversed.

In response, the limitations of non-rejected claim 4 are added to claim 1. As a result, the rejection is moot and should be withdrawn.

Rejection under 35 USC 103(a)

Claims 4 and 5 stand rejected under 35 USC 103(a) as being unpatentable over Barton et al. This rejection is respectfully traversed.

Barton et al discloses a method of converting a 1,2-diol into two carbonyl functionalities and bromine is also used and proves to be less successful (e.g., page 1232, right column, lines 6-7). However, Barton et al does not teach mixing previously a portion of the diol represented by the formula (1), the bismuth compound and the base, and adding the remaining diol represented by the formula (1) and bromine or the inorganic bromine compound to the resulting mixture simultaneously as now claimed. The Examiner admits at page 3 of the Action that the reference does not teach premixing only a portion of the diol and adding the remainder together with the bromine source.

The Examiner nonetheless takes the position that the claimed invention is an obvious variation of the cited prior art, a position with which applicants respectfully disagree.

The Examiner's attention is directed to the Examples in the specification. Specifically, comparing Examples 2 and 3 of the present specification, it is found that the yield in Example 2 was 86% and the yield in Example 3 was 97%. Example 3 is a result of the reaction comprising mixing previously a part of the diol represented by the formula (1), the bismuth compound and the base, and adding the remaining diol represented by formula (1) and bromine to the resulting mixture simultaneously. Example 2 is the result of the reaction comprising mixing the diol represented by formula (1), the bismuth compound and the base, and then adding bromine thereto.

Although Barton et al. discloses that bromine proves to be less successful, it is an unexpected result that the yield in Example 3 (97%) is superior to that in Example 2 (86%) despite the use of bromine. Applicants have thus demonstrated that the two-part addition yields unexpected results contrary to the position of the Examiner at page 4 of the Action.

The rejection is thus without basis and should be withdrawn.


The application is in condition for allowance, and an early indication of same earnestly is solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

Dated: April 17, 2007

By  #28,881
John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant